

REMARKS

Claims 1-16 are pending in this application.

By this Amendment, claim 2 is amended and new claim 16 is added. Support for the amendment to claim 2 can be found in the specification at, for example, page 45, lines 10-14 and Examples 1 to 3. Support for new claim 16 can be found in the specification at, for example, page 40, lines 13-18 and page 42, lines 20-24. No new matter is added.

Also by this Amendment, claims 4 and 15 are amended to be in independent form, including all of the limitations of their base claims and any intervening claims. No new matter is added.

I. Allowable Subject Matter

Applicants thank the Examiner for the indication in the Advisory Action that claims 4 and 15 are objected to as being dependent upon a rejected base claim, but are otherwise allowable. Claims 4 and 15 are amended into independent form herein. Accordingly, claims 4 and 15 should be allowed.

II. Rejections Under 35 U.S.C. §102(e)

In the previous Final Rejection, claims 1-3, 13, and 14 were rejected under 35 U.S.C. §102(e) as being anticipated by Sarkar et al. (U.S. Patent No. 6,465,081) ("Sarkar"). Applicant respectfully traverses the rejection as it may be applied to the pending claims.

A. Claims 1-3, 13 and 14

Independent claim 1 is directed to an image recording material comprising: a substrate having transparency; an image being formable by an electrophotography system on one side of the substrate; and a transparent characteristic controlling member provided at a side of the substrate opposite to the side where the image is formed, wherein the image can be seen when viewed through the substrate. Independent claim 14 is directed to an image recording material comprising: a substrate having transparency; an image being formable by

an electrophotography system on one side of the substrate; and a characteristic controlling means provided at a side of the substrate opposite to the side where the image is formed, wherein the image can be seen when viewed through the substrate. Such image recording materials are not disclosed by Sarkar.

The Office Action argues that, "Sarkar discloses an image receptor sheet comprising a substrate having two opposite sides, an ink receptive layer on one side of the substrate, and an ink repellent layer on the other side of the substrate, wherein the ink repellent layer is toner powder receptive so as to allow the image receptor sheet to be used in electrophotographic printers" (Office Action, page 3). According to the Examiner, the ink repellent layer of Sarkar is transparent and corresponds to the side of the substrate wherein the electrophotographic image is formed in the claims, and the ink receptive layer of Sarkar is transparent, comprises resin and filler, and corresponds to the characteristic controlling member in the claims. The Examiner further asserted that the Sarkar substrate is transparent.

The Examiner concluded that, "[s]ince the ink receptive layer is substantially identical to the claimed characteristic controlling member, the layer *inherently* functions as [a] glossiness controlling layer that reduces glossiness. Since all . . . three layers are transparent, an image that may be provided on the ink repellent toner receptive layer can be seen when viewed through the substrate" (emphasis added) (Office Action, page 3).

According to Sarkar, the ink receptive layer is coated on the side of the substrate that receives the image (col. 9, Example 9). The ink receptive coating comprises at least one layer of a hydrophilic polymer or blend of polymers and may include additives, such as fillers (col. 5, line 60, to col. 6, line 15). The filler "may be used to modify the mechanical properties of the [ink-receptive] coating" and may include colloidal silica and alumina (col. 6, lines 39-42).

The Examiner stated that the Sarkar ink receptive layer corresponds to the characteristic controlling member of the claims. However, in claims 1-3, 13, and 14, the

characteristic controlling member controls, including reduces, glossiness. There is no indication in Sarkar that the ink receptive layer has or even could be made to have this capability. In order to anticipate a claim, the cited reference must disclose every limitation of the claim. Since Sarkar does not disclose glossiness control, Sarkar cannot anticipate the claims.

The resins and fillers referenced by the Examiner are exemplified in Examples 1 and 9, as polymethylmethacrylate microspheres and colloidal hydrated alumina, respectively. Regarding the filler, Sarkar states that, "[f]illers may be used to modify the mechanical properties of the coating, *provided that such materials do not compromise the transparency of the layer*. Suitable materials include colloidal . . . alumina" (emphasis added) (col. 6, lines 40-43). Thus, the filler, the colloidal hydrated alumina, is added on the condition that it does *not* compromise transparency. In other words, the filler cannot significantly alter light transmittance. Since light transmittance correlates to light scatter and since light scatter correlates to glossiness, it follows that the inability of the filler to alter light scatter correlates to the inability of the filler to alter glossiness. If glossiness cannot be altered, then it certainly cannot be controlled.

Regarding the resin, Sarkar adds polymethylmethacrylate microspheres to the ink receptive coating compositions of Examples 1 and 9, for example, to control the friction of the sheet, *not* to control glossiness. This interpretation is supported by the Sarkar examples, wherein 30 μm polymethylmethacrylate microspheres are added to the ink receptive layer composition in a concentration of 0.1%. The ratio of polymethylmethacrylate to the polymer component (hydroxypropylmethylcellulose at a concentration of 5.6%) is 0.1:5.6, or approximately 0.02:1, which is too small a ratio to control glossiness. Thus, neither the filler nor the resin functions to control glossiness.

By the use of the term "inherently" in the Office Action, page 3, the Examiner suggested that the doctrine of inherent anticipation is applicable. However, inherency requires certainty, not probabilities or possibilities. Thus, the "mere fact that a certain thing may result from a given set of circumstances is not sufficient" to anticipate a claim.

Mehl/Biophile Int'l Corp. v. Milgraum, 192 F.3d 1362, 1365 (Fed. Cir. 1999). *See also In re Oelrich*, 666 F.2d 578, 581 (CCPA 1981) (holding a claim not inherently anticipated because the prior art did not "inevitably" contain the missing limitation). The Examiner did not provide any evidence supporting certain inherency of the glossiness control and, for the sake of argument (as Applicant does not assert that the following is correct), the mere possibility that Sarkar's ink receptive coating could control glossiness *is not sufficient* to establish inherent anticipation. Moreover, Applicant asserts that the Sarkar ink receptive coating does *not* control glossiness, as argued above.

Accordingly, for at least these reasons, claims 1-3, 13, and 14 are not anticipated by Sarkar. Reconsideration and withdrawal of the rejection are respectfully requested.

B. Claim 2

Claim 2 is further patentable over Sarkar. Claim 2 depends from claim 1, and adds the further limitations that the characteristic controlling member comprises a glossiness controlling layer that controls glossiness, and the glossiness controlling layer comprises a charge controlling agent. Sarkar additionally does not disclose at least the further limitation of claim 2 that the glossiness controlling layer comprises a charge controlling agent.

According to the claimed invention, by adding a charge controlling agent to the glossiness controlling layer, the surface resistance value of the image recording material that is required for electrophotography systems can be obtained. As a result, transferring property can be improved in the image transferring process. However, Sarkar does not disclose

incorporating such a charge control agent into the glossiness controlling layer, and does not disclose that any benefits could be obtained thereby.

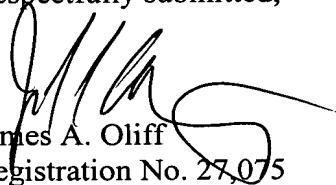
Accordingly, claim 2 is further patentable over Sarkar for the further limitations that the claim recites. Reconsideration and withdrawal of the rejection are respectfully requested.

III. Conclusion

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of the claims are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,


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